

REMARKS

Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-4, 7-10, 13 and 15-20 remain pending in the application.

No amendments to the claims are submitted concurrently herewith.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. §§§§ 101, 102, 103 and 112.

II. THE DOUBLE PATENTING REJECTIONS ARE OVERCOME

Claims 1-4, 7-10, 13 and 15-20 are rejected under the doctrine of nonstatutory double patenting as allegedly being non-patentably distinct with respect to USSN 10/539,274 (“the ‘274 application”), USSN 10/543,643 (“the ‘643 application”), USSN 10/543,637 (“the ‘637 application”), USSN 10/560,390 (“the ‘390 application”), and USSN 10/568,715 (“the ‘715 application”), and USSN 10/599,671 (“the ‘671 application”). Specifically, the Examiner opines that the compounds of the instant claims are obvious over those of the cited references in that they are homologs by virtue of an additional carbon atom linking the substituent at the 4-position of the saccharide to the saccharide itself. The Examiner alleges that the present claims are obvious over the cited references when in the present claims $n=0$. The Applicants respectfully disagree.

The judicially created doctrine of nonstatutory double patenting is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claims because the application claim is either anticipated, or would have been obvious over, the reference claims. *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

The Applicants request that the Examiner more closely examine the amendments entered on November 18, 2008, as the submission therein removed the “n” in the Markush recitation of

the claim set. Thus, the presently pending claims cannot meet the condition of $n=0$ as the Examiner extends, and are therefore distinct and non-obvious over those of the cited applications. Furthermore, the Applicants submit that the instant application relates to compounds structurally distinct from those of USSN 10/539,274 and USSN 10/599,671 as indicated in Figure 1.

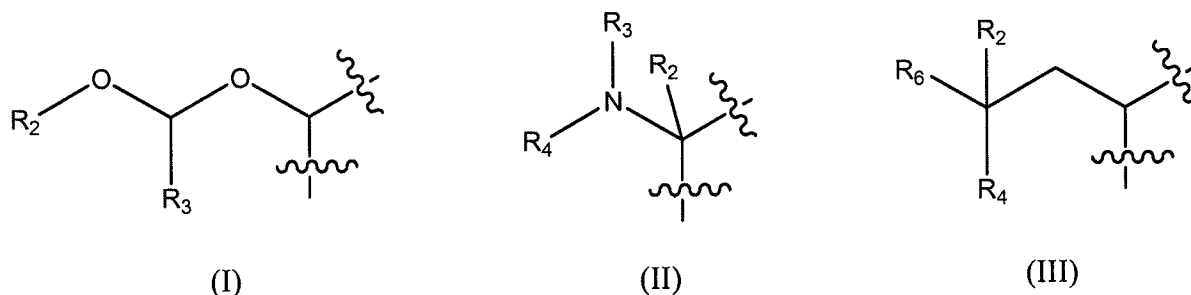


Figure 1. The 4'-substituents of the '274 application (I), the '671 application (II) and the instant claims (III).

The '274 application relates to compounds wherein the 4'-position of the sugar is substituted with a hemiacetal linkage comprising two oxygen atoms, one of which is directly appended to the saccharide [see Figure 1, compound (I)]. The '671 application relates to compounds wherein the 4'-position of the sugar is directly linked to a nitrogen atom [see Figure 1, compound (II)], and wherein the 4'-position is also substituted with a hydrocarbyl group (R_2 of compound (II) cannot be hydrogen). In stark contrast to structures (I) or (II), the instantly claimed compounds relate to those in which the 4'-position of the sugar is substituted with a single substituent (unlike those of the '671 application), and requires at least a two carbon chain between any heteroatom containing linker and the 4'-position of the sugar [see Figure 1, compound (III)]. As such, the compounds shown in Figure 1 cannot be considered homologous as they require distinct substituents and different substitution patterns at the 4'-position. The instantly claimed compounds are not simply homologues of those recited in either the '274 or the '671 applications as the Examiner alleges.

The distinct substitutions in the instantly claimed compounds confer unique steric (spatial), conformational and electronic properties to the structures, which in turn impart distinct characteristics to biological properties such as enzyme binding and inhibition, solubility, metabolic stability, pharmacokinetic parameters, etc. These properties cannot, *a priori*, be predicted to the skilled artisan, and are thus not obvious extensions over the cited references.

Additionally, the Applicants point out to the Examiner that the instant application claims priority to GB application 0302547.5, filed February 4, 2003. This filing date precedes the earliest effective US filing date of the PCT parent of the '274 application (filed December 19, 2003) and that of the PCT parent of the '671 application (filed March 9, 2005). Thus, both the '274 and the '671 applications are unavailable as prior art against the instant claims.

Accordingly, withdrawal of the double patenting rejections with respect to USSN 10/539,274 and USSN 10/599,671 are respectfully requested.

With respect to the double patenting rejections extended in view of USSN 10/543,643; USSN 10/543,637; USSN 10/568,715 and USSN 10/560,390, although the applicants disagree with the Examiner, a terminal disclaimer is being filed concurrently herewith solely for the purposes of expediting prosecution, and is presented without prejudice, without surrender of subject matter, and without any intention of creating estoppel as to equivalents.

Accordingly, withdrawal of the double patenting rejections with respect to USSN 10/543,643; USSN 10/543,637; USSN 10/568,715 and USSN 10/560,390 are respectfully requested.